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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,499	06/14/2002	Matthias Hessling	10191/2152	6405
26646	7590	01/11/2006	EXAMINER	
KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			NGUYEN, CINDY	
			ART UNIT	PAPER NUMBER
			2161	
DATE MAILED: 01/11/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/031,499

Applicant(s)

HESSLING ET AL.

Examiner

Cindy Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 19-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

This is in response to communication filed 11/21/05.

### ***Response to Arguments***

Applicant's arguments have been fully considered but they are not persuasive. Applicant amended the claims 19 and 30 as a "method for at least one of encoding, decoding and transmitting location information of objects for a map" is still allegedly directed to non-statutory subject matter. The claim language raises a question as to whether the claim is directed merely to an abstract idea, for example the information of objects for a map, the object can be the street number use for a map which would result in a practical application producing a non-statutory subject matter under 35 U.S.C. 101.

Claims 31, 33 and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. 35 U.S.C. 101 reads as follows: an encoding device or decoding device is just a tool, it's not limit to hardware, it can be a program module in the configuration to encoding, decoding, therefore, these claims present a non-function description.

Applicant argued that the data packet of Cotter does not including locating information and description information, and includes assignment information for assigning at least a part of the locating information to at least a part of the description information. In response, the data packet of Cotter includes destination address (location information) and description information (packet carries some elementary information about the direction of its destination) and assignment information (packet carries it destination address in the header) see col. 5, lines 45 to col. 6, lines 36.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Cotter discloses: the data packet includes destination address (location information) and description information (packet carries some elementary information about the direction of its destination) and assignment information (packet carries its destination address in the header) see col. 5, lines 45 to col. 6, lines 36.

### ***Claim Rejections - 35 USC § 101***

Claims 19-35 and 37 stand rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claims to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 19 only recites an abstract idea. The recites a method for encoding, decoding and transmitting location information. The encoding and decoding and transmitting location information method is an abstract idea, without need for physical computing equipment, and therefore constitutes non-statutory subject matter. The claim language raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

Claim 30 only recites an abstract idea. The recites a data format for at least one of encoding, decoding and transmitting location information. The encoding and decoding and transmitting location information method is an abstract idea, without need for physical computing equipment, and therefore constitutes non-statutory subject matter. The claim language raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

In the present case, claim 31 only recites an abstract idea. The recites an encoding device for encoding location information . The encoding device is an abstract idea, without need for physical computing equipment, and therefore constitutes non-statutory subject matter. The claim language raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

In the present case, claim 33 only recites an abstract idea. The recites an decoding device for decoding location information . The decoding device is an abstract idea, without need for physical computing equipment, and therefore constitutes non-statutory subject matter. The claim language raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine, which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

In the present case, claim 36 only recites an abstract idea. The recites a decoding device for decoding location information . A system for encoding, decoding is non-functional description material, without need for physical computing equipment, and therefore constitutes non-statutory subject matter. A system can be a program module in the configuration to encoding, decoding, therefore, these claims present a non-function description.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19, 28- 31, 33 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by Cotter et al. (US 6272548) (Cotter).

Regarding claims 19, 30, 31, 33 and 36, Mannings discloses: A method for at least one of encoding, decoding and transmitting location information, the method comprising:

at least one of encoding, decoding and transmitting location information of a data packet (col. 5, lines 45 to col. 6, lines 36, Cotter), the location information including locating information (destination address) and description information (each packet carries some elementary information about the general direction of its destination), wherein the data packet separately contains the locating information and the description information, and includes assignment information for assigning at least a part of the locating information to at least a part of the description information (col. 6, lines 15-36, Cotter).

Regarding claim 28, all the limitations of this claim have been noted in the rejection of claim 19 above. In addition, Cotter discloses: wherein the data packet includes a header part

of the location information and a data part of the location information (col. 5, lines 45 to col. 6, lines 36, Cotter).

Regarding claim 29, all the limitations of this claim have been noted in the rejection of claim 28 above. In addition, Cotter discloses: wherein the header part includes structure information specifying a data structure of the location information, and includes interpreting instructions specifying a purpose of the location information (col. 6, lines 16-36, Cotter).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20-27, 32, 34, 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotter et al. (US 6272548) (Cotter) in view of Mannings et al. (US 6169515) (Mannings).

Regarding claim 20, all the limitations of this claim have been noted in the rejection of claim 19 above. However, Cotter didn't disclose: wherein the locating information includes at least one first coordinate chain that includes at least one first point. On the other hand, Mannings discloses: wherein the locating information includes at least one first coordinate chain that includes at least one first point (col. 14, lines 14-22, Mannings). Thus, at the time invention was made, it would have been obvious to a



person of ordinary skill in the art to include the step wherein the locating information includes at least one first coordinate chain that includes at least one first point in the system of Cotter as taught by Mannings. The motivation being to enable the method give the instructions as the user negotiates a succession of function (decision points) the user can be directed to any destination, the users who are to be directed to the same exit from the junction are given the same instruction..

Regarding claim 21, all the limitations of this claim have been noted in the rejection of claim 20 above. In addition, Cotter/Mannings discloses: wherein the at least one first coordinate chain contains a second point, the at least one first point of the at least one first coordinate chain is specified in absolute coordinates and the second point of the at least one first coordinate chain is specified in relative coordinates, with respect to one of a centroid coordinate and the at least one first point of the at least one first coordinate chain (col. 13, lines 12-38, Mannings).

Regarding claim 22, all the limitations of this claim have been noted in the rejection of claim 21 above. In addition, Cotter/Mannings discloses: wherein the at least one first point of the at least one first coordinate chain is interpreted in a defined direction by the second point of the at least one first coordinate chain (col. 13, lines 12-38, Mannings).

Regarding claim 23, all the limitations of this claim have been noted in the rejection of claim 19 above. In addition, Cotter/Mannings discloses: wherein the description information includes at least one first attribute field (col. 9, lines 1-15, Mannings).

Regarding claim 24, all the limitations of this claim have been noted in the rejection of claim 23 above. In addition, Cotter/Mannings discloses: wherein the at least one first attribute field includes a type specification and description data, and the description data is determined by the type specification with respect to at least one of a name, an accuracy, a direction, a time, a point of interest and a physical link (col. 9, lines 1-15, Mannings).

Regarding claim 25, all the limitations of this claim have been noted in the rejection of claim 23 above. In addition, Cotter/Mannings discloses: wherein the assignment information includes at least one first assignment entry and the at least one first attribute field and the at least one first point of the at least one first coordinate chain are assigned to each other by the at least one first assignment entry (col. 14, lines 15-37, Mannings).

Regarding claim 26, all the limitations of this claim have been noted in the rejection of claim 25 above. In addition, Cotter/Mannings discloses: wherein the at least one first assignment entry includes a reference to the at least one first attribute field and a reference to the at least one first point of the at least one first coordinate chain (col. 14, lines 15-37, Mannings).

Regarding claim 27, all the limitations of this claim have been noted in the rejection of claim 25 above. In addition, Cotter/Mannings discloses: wherein the at least one first assignment entry includes one of (i) a reference to the at least one first attribute field and a reference to a plurality of points of coordinate chains of the locating information, and (ii) a reference to a plurality of attribute fields and a reference to the at least one first point of the at least one first coordinate chain<sup>1</sup> (col. 13, lines 12-45, Mannings).

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<sup>1</sup> The road junction connected between the roads as reference to the assignment entry.

Regarding claim 32, all the limitations of this claim have been noted in the rejection of claims 31 and 20 above. In addition, Cotter/Mannings discloses: wherein a definition of the at least one first point of the at least one first coordinate chain is definable as a function of location information query (col. 11, lines 55 to col. 12, lines 4, Mannings).

Regarding claim 34, all the limitations of this claim have been noted in the rejection of claim 33 above. In addition, Cotter/Mannings discloses: wherein the location information is at least partially correlatable with data of a first database associated with the decoding device (col. 7, lines 45-48, Mannings).

Regarding claim 35, all the limitations of this claim have been noted in the rejection of claim 34 above. In addition, Cotter/Mannings discloses: wherein at least one of location information that is not contained in the first database and location information is not correlated with data of the first database is stored in a second database associated with the decoding device (col. 7, lines 40-48, Mannings).

Regarding claim 37, all the limitations of this claim have been noted in the rejection of claim 20 above. In addition, Cotter/Mannings discloses: wherein the at least one first point includes a geographical point (col. 13, lines 12-38, Mannings).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on M-F: 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
Cindy Nguyen  
January 4, 2006

  
**MOHAMMAD ALI**  
**PRIMARY EXAMINER**